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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,122	05/20/2002	Fabien J. Brand	I1836.0677.NPUS00	8280
27551	7590	10/06/2004		
HOWREY SIMON ARNOLD & WHITE LLP 2941 FAIRVIEW PARK DR, BOX 7 FALLS CHURCH, VA 22042				
			EXAMINER TUCKER, PHILIP C	
			ART UNIT 1712	PAPER NUMBER
DATE MAILED: 10/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,122	BRAND ET AL.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 6 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 11 and 13 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 12 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobson Jr. (5783527).

Dobson teaches a well drilling or servicing fluid which comprises a hydrophobically modified starch or cellulose, and may comprise a hydrophobic bridging agent, such as a wax or resin which are oil soluble (column 6, lines 1-29). Servicing fluids are inclusive of fracturing and gravel packing fluids. The starch used may be crosslinked as in the present claim 13 (see example 5 and column 6, lines 1-7).

Dobson differs from the present invention in that a specific example of the combination of the hydrophobically modified starch or cellulose, and the hydrophobic bridging agent is not disclosed. It would however be obvious to one of ordinary skill in the art to utilize the hydrophobic bridging agent of wax or resin as taught by Dobson, in combination with the hydrophobically modified starch or cellulose, given the teaching of Dobson that such combination is useful for forming well drilling and servicing fluids. The use of the fluids of Dobson in fracturing and gravel packing would be obvious to one of ordinary

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skill in the art, given the teaching of Dobson that such fluids are useful in well servicing operations.

3. Claims 7, 8, 12 and 15 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 5, 6 and 14 are allowable over the art of record.

5. Applicants arguments have been considered but are not deemed persuasive with respect to Dobson. Dobson clearly teaches the use of both a hydrophobically modified modified starch or cellulose fluid loss additive, and a hydrophobic wax or resin as a bridging agent in a well fluid composition. Applicant has suggested that there is nothing within the teachings of Dobson that would lead to the utility of the hydrophobic bridging agent in this combination. Firstly, the group of specific bridging agents listed by Dobson in column 6, lines 19 –25 are so small as to be bordering on anticipation of the current claimed subject matter. One must consider *Merck & Co. v. Biocraft Laboratories* 10 USPQ2d 1843, concerning a factual situation similar to the present one, in which the court stated “That the ‘813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is true because the claimed composition is used for the identical purpose taught by the prior art”. In the present case, the fluids are used in the same well servicing operations, thus the use of the

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combinations disclosed by Dobson would be obvious to one of ordinary skill in the art.

The rejection is thus maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3144